REMARKS

Claims 1 through 15 are pending in this Application. A new Abstract has been submitted and claims 1 through 7 and 11 have been amended and new claims 12-15 added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, Examples 1, 3 and 4 appearing in Table 1, noting that claim 14 basically corresponds to original claim 5, while claim 15 basically corresponds to original claim 6. Applicants submit that the present Amendment does not generate any new matter issue.

Drawing Objection

The Examiner objected to the drawings asserting that the loss increase due to OH group must be depicted or the feature cancelled from the claims. This objection is traversed.

Specifically, the recited loss increase due to OH, as recited in claim 6, is **not a structural feature** of the claimed optical fiber which lends itself to illustration in a drawing. Rather, the recited loss increase due to OH group is an **optical characteristic** of the claimed optical fiber and, hence, **cannot** be shown in a figure.

Applicants, therefore, respectfully submit that neither 35 U.S.C. §113 nor 37 C.F.R. §1.81 requires illustration of a feature incapable of being illustrated, since such would not be necessary for an understanding of the invention disclosed or claimed. On this basis, Applicants solicit reconsideration and withdrawal of the drawing objection.

The Abstract

The Examiner cautioned as to the proper format of the abstract. In response, the abstract has been replaced consistent with the Examiner's guidelines.

Claims 1 through 4 and 7 through 9 were rejected under 35 U.S.C. §103 for obviousness predicated upon Cohen et al.

In the statement of the rejection, the Examiner admitted that the claimed optical fiber differs from that disclosed by Cohen et al. with respect to the dispersion range. Nevertheless, the Examiner concluded that the claimed invention would have been obvious because, according to the Examiner, the range of dispersion disclosed by Cohen et al. is close enough to that claimed. This rejection is traversed.

Firstly, the Examiner is without authority to ignore any claim limitation, regardless of how close the Examiner may perceive it to the applied prior art. This issue was put to bed by various decisions, notably *Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); In re Lange, 644 F.2d 856, 209 USPQ 288 (CCPA 1981); In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970).*

Moreover, claim 1 has been amended by reciting a cutoff wavelength of not more than 1330 nm. Cohen et al. neither disclose nor suggest any first higher order mode cutoff wavelength. There is no apparent factual basis upon which to predicate the conclusion that one having ordinary skill in the art would have been realistically impelled to modify the optical fiber disclosed by Cohen et al. by providing a first higher order mode cutoff wavelength, let alone one that is not more than 1330 nm as recited in independent claim 1. *Teleflex Inc. v. Ficosa North*

America Corp., 299 F.3d 1313, 63 USPQ2d 1374; In re Lee, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Based upon the foregoing, Applicants submit that the imposed rejection of claims 1 through 4 and 7 through 9 under 35 U.S.C. §103 for obviousness predicated upon Cohen et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claim 5 was rejected under 35 U.S.C. §103 for obviousness predicated upon Cohen et al. in view of Sarchi et al.

This rejection is traversed. Specifically, claim 5 depends from any of claims 1, 12 and 13. As to claim 5 dependent upon claim 1, Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. §103 for obviousness predicated upon Cohen et al. The additional reference to Sarchi et al. does not cure the argued deficiencies of Cohen et al. Accordingly, even **if** the applied references are combined as suggested by the Examiner, and Applicants do **not** agree that the requisite fact-based motivation has been established, the claimed invention would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).*

New Claim 12

New claim 12 is clearly free of the applied prior art, particularly since Cohen et al. neither disclose nor suggest any bending loss, let alone a bending loss as recited in new claim 12. Claim 5, dependent upon claim 12, is also free of the applied prior art, as the secondary reference to Sarchi et al. does not cure the argued deficiencies of Cohen et al. with respect to new claim 12.

New Claim 13

New claim 13 is clearly free of the applied prior art. Specifically, the optical fiber disclosed by Cohen et al. has a low chromatic dispersion and has a chromatic dispersion less than 5 ps/km • nm on at least one wavelength, noting page 3 of Cohen et al., lines 24 and 25. In contradistinction to optical fiber disclosed by Cohen et al., in accordance with the claimed invention, the chromatic dispersion of the claimed optical fiber is not zero at any wavelengths in the range of 1300 nm to 1600 nm.

Accordingly, claim 5 is also free of the applied prior art insofar as it depends upon claim 13, because the secondary reference to Sarchi et al. does not cure the argued deficiencies of Cohen et al. with respect to claim 13.

Based upon the foregoing, Applicants submit that the imposed rejection of claim 5 under 35 U.S.C. §103 for obviousness predicated upon Cohen et al. in view of Sarchi et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 6, 10 and 11 were rejected under 35 U.S.C. §103 for obviousness predicated upon Cohen et al. in view of Chang et al.

This rejection is traversed.

Claim 6 depends from any of claims 1, 12 and 13. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. §103 for obviousness predicated upon Cohen et al. and incorporate herein the arguments previously advanced asserting the patentability of claims 12 and 13 over Cohen et al. The secondary reference to Chang et al. does not cure any of the previously argued deficiencies in

traversing the imposed rejection of claim 1 or in arguing the patentability of claims 12 and 13. Accordingly, claim 6 is free of the applied prior art.

Claims 10 and 11 depend from independent claim 1, which specifies a cutoff wavelength in the range of 1300 nm to 1600 nm. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. §103 for obviousness predicated upon Cohen et al. The secondary reference to Chang et al. does not cure the argued deficiencies of Cohen et al.

Based upon the foregoing Applicants submit that the imposed rejection of claims 6, 10 and 11 under 35 U.S.C. §103 for obviousness predicated upon Cohen et al. in view of Chang et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

New Claims 12 through 15

Applicants previously set forth reasons distinguishing new claims 12 and 13 over Cohen et al.

New claims 14 and 15 are also free of the applied prior art. Specifically, as to claim 14, which basically corresponds to original claim 5, neither Cohen et al. nor Sarchi et al. disclose an exemplifying design of the claimed optical fiber. Accordingly, one having ordinary skill in the art could not possibly harbor any reasonable expectation of successfully obtaining an optical fiber corresponding to that claimed. *Vealander v. Garner __F.3d__ 68 USPQ2d 1769; In re Vaeck, 947 F.2d 488, 20 USPQ2d 1434 (Fed. Cir. 1991).*

As to claim 15, which basically corresponds to original claim 6, neither Cohen et al. nor Chang et al. disclose any way to make an optical fiber corresponding to that claimed. Accordingly, one having ordinary skill in the art would not have harbored a reasonable

expectation of successfully achieving an optical fiber corresponding to that claimed. *Vealander v. Garner, supra.; In re Vaeck, supra.* In this respect, Applicants would stress that the OH loss reduction in a quadruple-clad optical fiber disclosed by Cohen et al. is more difficult than in the step index single mode fiber disclosed by Chang et al.

Based upon the foregoing, it should be apparent that the imposed objections and rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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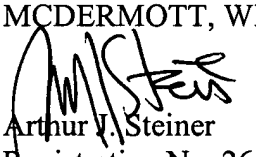

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